REMARKS

In response to the final Office Action dated September 7, 2006, Assignee respectfully requests reconsideration based on the amendments and remarks set forth herein. Assignee respectfully submits that all pending claims are in condition for allowance.

Claims 1-21 and 23-29 are pending. Claims 1, 11, 14, 21 and 28 are amended. Support for the amendments may be found in the Specification at paragraphs [0030], [0031], [0041], [0042], [0058] and [0060], for example. No new matter is submitted. Accordingly, entry and consideration of the amendments are respectfully requested.

35 U.S.C. §102(e) Rejection

In the Office Action, claim 28 is under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 6,477,246 to Dolan (hereafter "*Dolan*"). The rejection is respectfully traversed.

A claim is anticipated only if each and every element is found in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir.1987). *See also* DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8th Edition) (hereinafter "M.P.E.P."). As the Assignee shows, however, *Dolan* fails to include every element of the pending claims. *Dolan*, thus, does not anticipate the features recited in claim 28. Accordingly, the Assignee respectfully requests that the Office remove the 35 U.S.C. §102(e) rejection of claim 28.

Independent claim 28 is set forth in full above and generally recites a method for associating a subscriber number with an incoming call, and determining if the incoming call comprises a priority caller. More particularly, claim 28 recites, *inter alia*, "*storing the subscriber number, the priority caller information, and at least one instruction from the subscriber in a database.*" The database is consulted to determine whether the incoming call is a priority caller, and, if so, then how to handle the priority caller. *Dolan* does not teach or disclose the combination of features recited in claim 28, because *Dolan* does not teach, disclose or suggest a

Page 12

database in which the subscriber number, the priority caller information, and at least one instruction from the subscriber is stored to aid in determining whether an incoming call is a priority caller, and, if so, how to handle such priority caller.

The Office Action is correct to the extent that *Dolan* discloses a system and method for handling incoming telephone calls. U.S. Patent No. 6,477,246 to Dolan, et al. (November 5, 2002) at Abstract and column 1, lines 11-15 (hereafter *"Dolan"*). *Dolan*, however, expressly requires the aid of a software-based Command Center (25) at the subscriber's end in order to handle the incoming calls in association with a central server (29). *Id.* at Abstract; column 1, lines 11-15 and lines 40-42; column 2, lines 60-62; and column 6, lines 20-38. The central server (29) of *Dolan* is thus used to capture and store a dynamic profile of the subscriber's rules for handling incoming calls as the incoming calls occur. Dolan expressly explains that *"The subscriber is not asked to enter his rules for handling calls but rather the subscriber is presented with rules determined implicitly by the central server (28)." See, Id.* at column 6, lines 20-22 and 35-38. The subscriber in *Dolan* thus only approves or rejects rules that are gradually determined by the central server as the subscriber's preferences are learned by the central server. *See, Id.* at column 6, lines 34-38 and lines 48-50. The determination of rules as calls occur in *Dolan* differs from the pre-determined at least one instruction entered by a subscriber in pending claim 28, and in all other pending independent claims. The Response to Argument section of the Office Action does not address the deficiency of *Dolan* in this regard. Moreover, as explained in the previous Request for Reconsideration, the system and method of *Dolan* requires the software-based command center that is not required by any of the pending independent claims.

Dolan thus fails to provide the combination of features recited in claim 28, including, at least, a database having a subscriber number, calling party information, and at least one instruction from the subscriber stored therein to determine whether an incoming call is a priority caller, and, if so, how to handle such priority caller. Assignee therefore respectfully requests that the 35 U.S.C. §102(e) rejection of claim 28 be removed.

35 U.S.C. §103(a) Rejections

In the Office Action, claims 1-8, 11-18, 21, 23-25 and 29 are rejected under 35 U.S.C. §103(a) as allegedly unpatentable over *Dolan* in view of U.S. Patent No. 6,058,171 to Hoopes (hereafter *"Hoopes"*), and claims 9-10, 19-20, and 26-27 are rejected under 35 U.S.C. §103(a) as allegedly unpatentable over *Dolan* in view of *Hoopes* as applied to claims 1-8, 11-18, 21, 23-25, and 29 above, and in further view of U.S. Patent No. 6,922,411 to Taylor (hereafter *"Taylor"*). For the following reasons, these rejections are respectfully traversed.

1. ***Dolan* "Teaches Away" and Cannot Support a *Prima Facie* Case of Obviousness**

Dolan "teaches away" from the subject matter of the pending claims. A reference that 'teaches away' from the claimed invention is a significant factor when determining obviousness. *See* MPEP at §2145 (X)(D)(1). A reference must be considered as a whole, including portions that lead away from the claimed invention. *See id.* at §2143.02; *see also W.L. Gore & Assoc., Inc. v. Garlock, Inc.* 220 U.S.P.Q. (BNA) 303 (Fed. Cir. 1983), *cert. denied,* 469 U.S. 851 (1984). "It is improper to combine references where the references teach away from their combination." MPEP at §2145 (X)(D)(2). If the proposed combination changes the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to support a *prima facie* case. *See* MPEP at §2143.01.

Pending independent claims 1, 11, 14, 21 and 28 are generally directed to subject matter that includes one of a system or method for associating a subscriber number with an incoming call, and determining if the incoming call comprises a priority caller. More particularly, independent claim 1 recites a system in which a query is launched upon detection of an incoming call to determine whether the incoming call is a priority caller by *inter alia, "referring to a database storing the subscriber number, the priority caller information, and at least one instruction from the subscriber."* The database is thus consulted to determine whether the incoming call is a priority caller, and, if so, then how to handle the priority caller. Independent claims 11, 14, 21 and 28 recite similar subject matter.

Page 14

The Office's alleged *prima facie* case requires impermissible changes to the principle of operation of *Dolan*. As explained above, *Dolan* discloses a system and method for handling incoming telephone calls. U.S. Patent No. 6,477,246 to Dolan, et al. (November 5, 2002) at Abstract and column 1, lines 11-15 (hereafter "*Dolan*"). *Dolan*, however, expressly requires the aid of a software-based Command Center (25) at the subscriber's end in order to handle the incoming calls in association with a central server (29). *Id.* at Abstract; column 1, lines 11-15 and lines 40-42; column 2, lines 60-62; and column 6, lines 20-38. Moreover, although the central server (29) of *Dolan* is used to capture and store a dynamic profile of the subscriber's rules for handling incoming calls as the calls occur, *Dolan* expressly explains that "*The subscriber is not asked to enter his rules for handling calls but rather the subscriber is presented with rules determined implicitly by the central server (28).*" *See, Id.* at column 6, lines 20-22 and 35-38. The subscriber in *Dolan* thus only approves or rejects rules that are gradually determined by the central server as the subscriber's preferences are learned by the central server. *See, Id.* at column 6, lines 34-38 and lines 48-50. The determination of rules as calls occur in *Dolan* differs from the pre-determined at least one instruction entered by a subscriber before calls occur as recited in each of the pending independent claims. To modify *Dolan* to provide that the subscriber actively inputs at least one instruction for handling priority calls before incoming calls occur and without the aid of a soft-ware based command center, as recited in each of the pending independent claims, would thus alter the principle of operation of the system and method of *Dolan* that does not ask the subscriber to enter rules for handling such incoming calls. *Id.* The Office's *prima facie* case, therefore, requires a change to the principle of operation of *Dolan*. The patent laws, however, forbid such changes to support an obviousness rejection. *Dolan* thus teaches away from the pending claims and cannot be used to support a *prima facie* case of obviousness in combination with either of *Hoopes* or *Taylor*. Moreover, as explained in the previous Request for Reconsideration therefore, *Dolan* requires a software-based command center to handle the transmission of incoming calls, which software-based command center and command center is wholly omitted in the pending independent claims. All remaining claims depend from one of pending independent claims 1, 11, 14, 21 and 28. Accordingly, withdrawal

of the 35 U.S.C. §103(a) rejections of claims 1-21, 23-27 and 29 based on any combination including *Dolan* is respectfully requested.

2. Because No Reasonable Expectation of Success was Cited, the *Prima Facie* Case Is Defective

The Examiner's alleged *prima facie* case based on a combination of *Dolan* with either of *Hoopes* or *Taylor* is defective. A *prima facie* case for obviousness must include "a reasonable expectation of success". MPEP at §2143. Here, however, no basis for successfully combining *Dolan* with either of *Hoopes or Taylor* to provide the combination of features including at least one subscriber entered instruction stored in a database for recognizing priority calls and determining how to handle such priority calls, as generally recited in each pending independent claim, has been cited in the Office Action. All other claims ultimately depend from one of the pending independent claims. Because the Office has entirely failed to make such a finding, the Office has failed to properly establish a *prima facie* case for obviousness. Accordingly, withdrawal of the 35 U.S.C. §103(a) rejections of claims 1-21, 23-27 and 29.

REQUEST FOR ONE MONTH EXTENSION OF TIME & AUTHORIZATION FOR PAYMENT OF FEES

Assignee respectfully requests herein an additional one month extension of time to respond to the Office Action mailed September 7, 2006. Payment of the requisite fee for the one month Extension of Time to Respond, i.e., until January 7, 2007, and payment for the RCE are authorized hereinbelow.

Description of Fee	Amount
One Month Extension of Time Fee	$120.00
RCE	$790.00
Total	$910.00

Page 16

The Assignee, therefore, includes a Credit Card Payment Form PTO-2038 for $120.00. If there are any other fees due in connection with the filing of this response, please charge the fees to the credit card on file. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such an extension is requested and the fee should also be charged to the credit card on file.

CONCLUSION

Assignee submits that all rejections to date have been overcome upon entry and consideration of this Amendment. Further, none of the references cited by the Office, alone or in combination disclose or suggest the claimed subject matter. Therefore, Assignee respectfully solicits a Notice of Allowance for all pending claims.

Of course, if the Examiner determines that anything further is desirable to place this application in even better form for allowance, then the Examiner is invited to contact the undersigned at (757) 253-5729, (757)-784-1978, or bambi@wzpatents.com.

Respectfully submitted,

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Date: 1/6/07

Page 17